BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the United States Circuit Court of Appeals for the Tenth Circuit is reported in *Band-It Company, a corporation and Dental Specialty Company, a corporation, Appellants, vs. Michael J. McAneny, Jr., Appellee,* 131 F. 2nd 766 (R. 317-323).

The opinion of the United States District Court for the District of Colorado is not reported but is in the record (R. 17, 19-20).

II.

JURISDICTION.

1. The judgment to be reviewed was entered November 13th, 1942 (R. 323) but petition for rehearing was duly filed with supporting brief (R. 325-338) and denied December 28th, 1942 (R. 339) and order was entered January 6th, 1943 staying mandate thirty days from that date (R. 339).

2. As basis for the jurisdiction of this Honorable Court, petitioners claim that the opinion (R. 317-323) and judgment (R. 323) of the Circuit Court of Appeals, in so far as they affirm the opinion and decree of the District Court (R. 17, 19-20, 22-23) are in conflict with the applicable decisions of this Honorable Court in the respects specifically set forth under heading B in the accompanying petition for writ of certiorari, and hereinafter elaborated. In the interest of brevity, said specific statements under heading B are requested to be considered as here incorporated by reference.

3. Jurisdiction of this Honorable Court is invoked under Judicial Code Section 240, as amended by the Act of February 13, 1925, 43 Stat. 938.

4. Jurisdiction of this Honorable Court is believed to be sustained by the following:

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211 at 217;

United Carbon Company et al. v. Binney & Smith Co., 63 S. Ct. 165; 87 L. Ed. 158; No. 71, decided Dec. 7, 1942. (first paragraph of opinion);

Rule 38 par. 5 (b) "or has decided a federal question in a way probably in conflict with applicable decisions of this court."

III.

STATEMENT OF THE CASE.

It is believed that the summary statement under A. in the petition, in view of the statement of reasons relied on under B. in the petition, gives a sufficiently full and clear statement of the case for present purposes and that a statement of the case at this point would consist only in duplication of that already given or of material necessarily included in the argument, wherefore in the interest of brevity the statement is not here repeated.

IV.

SPECIFICATION OF ERROR.

The specifications of reasons under B. in the petition states errors, intended to be urged, as clearly and as specifically as can be without anticipating the argument. It is requested that said specification of reasons be considered as here incorporated by reference.

V.

ARGUMENT.

The specification of reasons under B. in the petition summarizes the argument as clearly as can be done without duplication of some of the argument itself and in view of the simplicity of the matter involved a summary would unnecessarily lengthen this brief.

Point A.

By its construction of claim 1 of the Campbell patent No. 2208114 the Circuit Court of Appeals recaptured, revived and restored to the patent the subject matter of claims which patentee, during the course of the prosecu-

tion of his case in the patent office, cancelled, surrendered and abandoned.

The Circuit Court of Appeals held that

> "The primary improvement in the device is the means by which the band may be inserted sidewise into the cutting element rather than being threaded into the cutting element, thus requiring only one cutting of the band, permitting the use of a continuous band, and preventing waste. In prior devices a strip had to be cut of sufficient length to band the hose and also to reach through the cutting device and fasten to the slide member to apply the tension" (131 F. 2nd 766 at mid. 1st col. 767.)

and that

> "The whole emphasis of the applicant in the patent proceedings was upon the construction of the cutting member which permitted the band to be inserted sidewise instead of by threading, thereby eliminating one cutting operation, permitting the use of a continuous band, and effecting the saving of band material, thus, by a new combination, producing an old result in a more facile, economical, and efficient way" (mid. 2nd. col. 767).

a. While said feature (the sidewise insertion of the band in the cutting element) was emphasized in the specification; was included (originally or by amendment) in each of the eleven claims filed (except claim 8); was fought for in applicant's amendments and arguments (Paper No. 4, pgs. 213-218 and Paper No. 8, pgs. 219-223), it was each time denied and rejected by the Patent Office (Paper No. 3 pgs. 211-213, Paper No. 7 pgs. 218-219 and Paper No. 9 pgs. 223-224) and was surrendered in part by applicant's cancellation of claims 6, 10 and 11 (pg. 213) and claims 2 and 5 (pg. 219) and finally and wholly surrendered by applicant's cancellation of the remaining claims covering this feature (claims 1, 3, 4, 7 and 9) in Paper No. 12 (pgs. 229-230) after having taken an appeal on those claims (pgs. 227-229).

b. Appellee admitted of record in this case (by C. D. Campbell, one of appellee's attorneys, also his expert wit-

ness and the attorney who prosecuted the Campbell application R. 38-39) that every effort was made in the patent proceedings to obtain claims covering the "open ended cutting member and an open sided slot through which the band could be inserted sidewise"; that all such claims were rejected; that an appeal was taken and withdrawn and the claims cancelled and the action of the examiner in rejecting the claims was "thereby accepted" and that no claim was obtained that did not contain the limitation to "an eccentric removable key or eccentric key adapted to be journaled" and that the rejected and cancelled (surrendered) claims were broader than the two finally allowed (bot. 188 through 192).

c. From the whole record it appears that appellee never contended that either claim was infringed by the use of the open sided cutting element; that the lower court found nothing of this kind; that appellee's contention throughout was that the band-gripping means in the Band-It slide member were the mechanical equivalent of the removable key for gripping the band in the Campbell device and, therefore, was an infringement. The District Court so found and based its decision thereon (bot. pg. 19) and the record is devoid of facts, contentions or findings on which to base any other or different construction of the claims.

d. In construing Claim 1 of the Campbell Patent according to the foregoing quotations from the opinion, the Circuit Court of Appeals has revived, recaptured and restored to the patent the subject matter of the ten claims which were fought for, rejected, cancelled and surrendered and, in so doing, held contrary to the unquestioned rule of patent law, as recently announced by this Honorable Court, namely:

> "But the particular invention to which the patentee has made claim in conformity to the statute is not always to be ascertained from an inspection of the specifications and claims of the patent alone. Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned

claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed."

* * * * *

"It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." (Many citations.)

"The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest."

Schriber-Schroth Co. vs. Cleveland Trust Co., 311 U. S. 211 at 217-218, 220-221.

Also in Exhibit Supply Co. vs. Ace Patents Corp., 315 U. S. 126, 62 Sup. Crt. Rptr. 513.

The last case emphasizes that it matters not whether the patent office was right or wrong.

Point B.

By its construction of claim 1 of the Campbell patent in suit the Circuit Court of Appeals has so changed and enlarged the scope of the claim as to render it invalid in view of any one of at least three prior art patents of record, namely,

Surmay (pg. 300 *et seq.)* fully discussed by the patent office examiner in rejecting the claims (pgs. 211-212, 218-219 and 223-224). Band from a roll is tensioned around a hose and cut close to the hose in a cutting element having an open end rotary shear and an open sided slot through which the band can be inserted sidewise as held by the examiner.

Hoffmann (pg. 272 *et seq.)* not cited by the examiner but described by witness Sweet (pgs. 91-94) and admitted by attorney-witness Campbell (pgs. 188 and 191) to show a slot in a cutting head or element for sidewise insertion of a band, which device cuts "the tensioned

tie from a roll or coil'' as described in the specification and especially lines 18-19, col. 1, pg. 1, and on pg. 2 at line 45, col. 1 to line 8, col. 2.

Hultgren (pg. 306 *et seq.)* not cited by the examiner but described by Sweet (pgs. 91 and 94-95) and admitted by Campbell at pgs. 184 and 185.

Point C.

In making the above quoted statement that ''In prior devices a strip had to be cut of sufficient length to band the hose and also to reach through the cutting device and fasten to the slide member to apply the tension'' the Circuit Court of Appeals overlooked the prior art patents and especially Surmay, Hoffmann and Hultgren, each of which has an open sided slot for sidewise insertion of a continuous band, as above pointed out, and thus in trying to restore to the patent the subject matter of surrendered claims, contrary to the above cited decisions of this Honorable Court, so enlarged the claim as to render it invalid.

Point D.

In holding that, because the word ''key'' was not expressly modified in claim 1 by the word ''removable'', functional removability of the key is not an element of the claim, the Circuit Court of Appeals failed to limit the claim to a key functionally removable contrary to the applicable decisions of this Honorable Court.

The Circuit Court of Appeals stated (Opinion 2nd column, page 767) that:

> ''The removable key is not an element of claim 1 of the patent in suit and was not referred to in the patent proceedings as a basis for the allowance of the claims. Claim 1 was allowed prior to the allowance of claim 2. Claim 1 does not call for a removable key.''

In making the foregoing statement and in drawing therefrom the conclusion of infringement by the accused device, the Circuit Court of Appeals overlooked certain facts in the patent office proceeding, in the testimony of appellee's

attorney-witness Campbell, and statements in appellee's brief, namely,

a. That appellee in the patent office proceeding, at the trial and in the brief in the Circuit Court of Appeals disclaimed any invention in claim 1 of the patent except that defined in original claim 8; that appellee's brief, page 5, states:

> "There can be but one conclusion: The Examiner at all times recognized the invention in claim 8, now claim 1 of the patent";

that Campbell who prosecuted the case in the patent office testified for appellee at trial that "patented claim 1 is in reality claim 12 of the prosecution record. Claim 12 is original claim 8 rewritten at the suggestion of the Examiner to expand it to include enough structure to make an operative device" (page 36); that he further testified as follows:

> "Q. I will ask you if in claim 1, which was original claim 12, you find any change whatever from claim 8 as originally put in, insofar as invention is concerned?
>
> "A. No difference so far as the patented features of the invention are concerned.
>
> "Q. Extending merely to additional structure?
>
> "A. That is right.
>
> "Q. To house the structure?
>
> "A. Claim 1 differs from claim 8 only in that it includes additional structure inherently present in the device," (pg. 37);

that in paper No. 8 (pages 219 to 223) this witness, as attorney in charge of prosecution, cancelled original claim 8 and substituted claim 12 (now claim 1 of the patent) making the following statement of record:

> "New claim 12, is, in reality, claim 8 rewritten to avoid excess amendment and to comply with the suggestions contained in the Office Action of February 25, 1939, paper No. 7. Since claim 12 does embody the Examiner's suggestions and since it does set forth novel structure in a tool of this character, allowance of this claim appears in order without further argument";

that original claim 8 (identified by appellee's attorneys and witnesses as defining all of the invention which is now in claim 1 of the patent) reads as follows:

> "In a tool of the character described, a slide providing key bearings, a rotary cam on the slide, and a removable key adapted to be journalled in the bearings adjacent to cam and having an eccentric co-acting with the cam for gripping the band."

b. That the obvious reason that the removable key "was not referred to in the patent proceeding as a basis for the allowance of the claims" is that original claim 8 claimed nothing but the combination of "a slide providing key bearings, a rotary cam on the slide, and a removable key adapted to be journalled in the bearings adjacent to cam and having an eccentric co-acting with the cam for gripping the band"; that such an exceedingly limited combination was apparently patentable and as the claim was expressly limited to a removable key there was no reason for the Examiner to mention this element; that when claim 12 was substituted for claim 8 with the statement that "New claim 12 is, in reality, claim 8 rewritten" and for that reason its allowance was requested without argument, applicant put himself on record to the effect that the key referred to in new claim 12 as "an eccentric key adapted to be journalled in the bearings" was the same key defined in original claim 8 and was a removable key; that Campbell confirmed this construction at the trial by his testimony above quoted and appellee's attorneys have confirmed it in the brief by the above quotation therefrom, and having obtained the allowance of claim 12 (claim 1 of the patent) upon applicant's statement that the claim was simply a rewriting of claim 8 to include elements "to house the structure" defined in claim 8, and having confirmed that construction by testimony in the lower court and by above quoted statement in brief in this court, appellee is estopped to claim a broader construction of claim 1 than he could have claimed for original claim 8; that the record therefore contains no basis for a construction of claim 1 broader than could have been given to original claim 8; that, therefore, claim 1 is limited to a removable key.

c. That regardless of the presence or absence of the

word "removable" in claim 1, the claim is necessarily limited to a key which is placeable and removable as a necessary part of the operation of the tool; that Campbell testified that while the eccentric element in the Band-It device is removable only structurally, that is, as a part of the dis-assembling of the tool and is not removable as a part of the functioning of the tool, the key in the Campbell device is removable as a part of the function of the Campbell tool and that such removability is "necessary in order that the device function in accordance with the teaching of the patent" (page 53); that Campbell testified to the same effect at other places and Sweet testified to the same effect, and there is no dispute on that point.

Point E.

In affirming the District Court's decree of infringement of claim 1 of the Campbell patent the Circuit Court of Appeals affirmed the District Court's holding that petitioners' band-gripping structure, having no functionally removable key, is the mechanical equivalent of the band-gripping structure defined in said claim and thereby decided a patent law question contrary to the applicable decisions of this Honorable Court.

At this stage of the proceeding we shall not prolong this brief by any argument in support of this point.

Suffice it to say that *Schriber-Schroth Co. vs. Cleveland Trust Co.*, 311 U. S. 211 at 221, expressly recognizes the rule that the doctrine of equivalents cannot be used to revive and restore to the patent that which has been abandoned by amendment or cancellation of claims and the parts of the record above referred to are sufficient to show that both lower courts thus misused the doctrines of equivalents.

Point F.

In holding that claim 1 of the Campbell patent reads "squarely" on the accused device the Circuit Court of Appeals was in error but, even did the claim so read, the holding that such reading is conclusive of the question of infringement is in conflict with the applicable decisions of this Honorable Court.

a. The Band-It device not only has no "removable key" (to which claim 1 must be limited as above pointed out) but it has no "key adapted to be journaled in the bearings" as that term must be read in the light of appellee's patent office record, testimony at trial and brief in the Circuit Court of Appeals.

b. Infringement cannot be found simply from a literal reading of the claim on the accused device or from identity of result.

> "The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute, has to be convicted, when he has done nothing in conflict with its spirit and intent" (and much more to same effect).
>
> Westinghouse vs. Boyden Power Brake Co., 170 U. S. 537, 568.

To same effect:

> Hazeltine Corporation vs. Emerson Television-Radio, Inc., C. C. A. 2nd, 129 F. (2d) 580, 582.

Identity of result is not a sufficient test of infringement.

> Ruth vs. Climax Molybdenum Co., 93 F. (2d), 699, 703.

CONCLUSION.

It is, therefore, respectfully submitted that this case is one calling for the exercise by this Court of its supervisory powers, in order that the conflict between the applicable decisions of this Court and the judgment of the Circuit Court of Appeals for the Tenth Circuit may be eliminated, and that to such an end a writ of certiorari should be

granted and this Court should review the decision of the Circuit Court of Appeals for the Tenth Circuit and finally reverse it insofar as the said decision affirms the decision of the District Court for the District of Colorado.

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